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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,965	03/28/2001	Takao Yoshimine	275745US6	4221

22850 7590 04/09/2007  
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3622

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	04/09/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 04/09/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

**Office Action Summary**

Application No.

09/819,965

Applicant(s)

YOSHIMINE ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 37-43,45-54,56-65,67-69 and 97 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-43,45-54,56-65,67-69 and 97 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 37-43, 45-54, 56-65, 67-69 and 97 are rejected under 35 U.S.C. 103(a) as being obvious over Logan et al. (US005721827A).

3. Logan et al. teaches (independent claims 37, 48, 59 and 97) an apparatus, method and program for determining a refund, the method comprising:

accessing content data (*programming*) provided by a content creator<sup>1</sup>, the content data including advertising data (*programming and advertising segments*, col. 6 lines 56-60);

transmitting, via a network (col. 4 line 13 and Fig 1) selected content data/*programming* to one or more user locations (players 103, col. 2 line 63 to col. 3 line 9), in response to a request from the one or more user locations for the selected content data/*programming* (col. 6 lines 45-51);

calculating *royalties*, which reads on a share of profits (para. xx below), to be earned by the content creator as a function of the number of transmissions of the selected content data/*programming*, and whether the selected content included advertising data (col. 20 lines 3-20); and

storing and accumulating the *royalties*/share of profits to be paid to the content provider in a content provider information database (account number of the content creator, col. 17 lines 15-19, where the content creator is identified in a *Content Providers Table 315*, col. 16 lines 38-46).

4. Logan et al. does not teach that the accessed content data includes advertising data affixed thereto. It is common, and therefore obvious, for creators and distributors of content to affix

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<sup>1</sup> The content is inherently provided by a "content creator" because the content cannot create itself.

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promotional material thereto, a copyright statement for example. Any promotional material reads on "advertising".<sup>2</sup>

5. Logan et al. does not teach that said advertising data is affixed based on commercial desired data generated in response to a selection by the content creator, which the examiner interprets as the advertising being selected and affixed by or at the expressed wishes of the content creator. This is obvious for the reason stated in para. 4 above. The "commercial desired data" could, for example, be a copyright statement.
6. Logan et al. teaches paying compensation to *each person or firm which supplies royalty-bearing information*; Logan et al. uses the term *content provider* for each such person or firm (col. 16 lines 41-43). A "content creator" is surely someone providing royalty-bearing information and is therefore taught by the *content provider* of Logan et al. Indeed, the claims are limited to "content data provided by a content creator", so the claims themselves acknowledge that the content creator is a content provider. "Profit" is not given a "clear definition" in the specification (footnote 2), and indeed has no precise definition in accounting. One of ordinary skill in the art would understand that *royalties* provided to content creators/content providers reads on the claimed "share of profits for the content creator".
7. Logan et al. also teaches at the citations given above claims 38, 49 and 60; claims 40-41, 51-52 and 62-63, where *subscription cost* (col. 10 line 1) reads on connection fee and use fee; and claims 45, 56 and 67 inherently.
8. Logan et al. also teaches at the citations given above claims 39, 50 and 61 (col. 9 lines 5-11); claims 42, 53 and 64 (col. 9 lines 62-63); 43, 54 and 65 (col. 9 lines 5-11, where *defray subscription costs* reads on applying the credit to a purchase over the network); and claims 47, 58 and 69, where *royalty payments due to content providers* (col. 15 lines 40-41) reads on contributions.

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<sup>2</sup> Here and later the examiner has had to give a term its broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). The examiner is required to do so unless a term is given a "clear definition" in the specification (MPEP § 2111.01). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". An example does not constitute a "clear definition" beyond the scope of the example.

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9. Logan et al. does not teach (claims 46, 57 and 68) that the ad is placed at the head (beginning) of the content. Because it is common practice to begin programming with advertising, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to the teachings of Logan et al. that the ad is placed at the head (beginning) of the content.

### ***Response to Arguments***

10. Applicant's arguments filed with an amendment on 9 January 2007 have been fully considered but they are not persuasive.
11. For applicant's benefit, it is noted that a disclosed limitation is not patentable. At each para. [0159] and [0176] of the published application, it is disclosed that the affixed advertisement could be a "commercial video". This would not a patentable limitation. Although the Office does respect some distinction between "content" and "advertising", it cannot be carried too far because the distinction is not always clear in practice. Advertising can be mixed with "content" or "programming". For example, travel programming that displays airline logos is in fact advertising those airlines. One of ordinary skill in the art would understand that the "programming" taught by Logan et al. could readily contain advertising, and be treated as such. Applicant's disclosure at para. [0159] and [0176] would be interpreted as such content/programming containing advertising.

### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
13. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

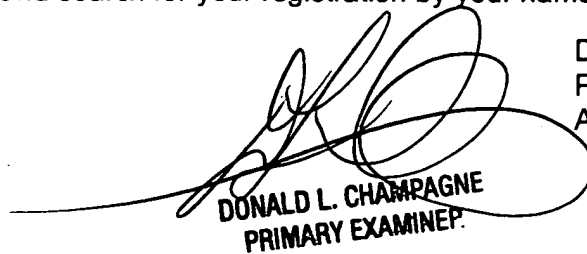
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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.
15. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.
16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
17. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
18. Applicant may have after final arguments considered and amendments entered by filing an RCE.
19. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov).

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31 March 2007



DONALD L. CHAMPAGNE  
PRIMARY EXAMINER

Donald L. Champagne  
Primary Examiner  
Art Unit 3622